

## **REMARKS**

Reconsideration is respectfully requested.

### **Claim Amendments**

In this Amendment, applicants have amended claims 1 and 17 and cancelled withdrawn claims 6-16 and 18-20 from further consideration in this application. Applicant is not conceding that the subject matter encompassed by claims 1 and 6-20 prior to this Amendment is not patentable over the art cited by the Office. Claims 1 and 17 were amended and claims 6-16 and 18-20 were cancelled in this Amendment solely to facilitate expeditious prosecution the application. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by claims 1 and 6-20, as presented prior to this Amendment and additional claims in one or more continuing applications.

### **Claim Rejections – 35 U.S.C. 101**

Claims 1-5 and 17 were rejected under 35 U.S.C. 101 on the ground that the claimed subject matter is directed to non-statutory subject matter. With respect to independent claim 1, the term “node” is said to be capable of being “software or a module that behaves like a node.” With respect to independent claim 17, the term “agent” is said to represent software per se, and covers a mere abstract idea incapable of producing “a concrete, useful and tangible result.”

These rejections are rather curious because each claim recites operational elements that are “adapted to” perform specified actions. Non-statutory software of the type prohibited by section 101 represents source code that is not capable of performing any function. However, once the code is compiled or interpreted into executable instructions stored in a memory or other medium, it becomes capable of performing a function and is thus statutory. Software resident in

a machine is effectively hardware because it defines the machine state. Thus, when the Office states that the node of claim 1 could be interpreted “to be software or a module that behaves like a node,” the proper response is that this observation is irrelevant. Any software or module that “behaves,” i.e., has a behavior, must be resident in or otherwise capable of execution in a statutory machine. Otherwise it would not be performing a function and thus would not “behave” in any manner whatever. Software doesn’t execute by itself, so the claims must inherently recite an operational machine if they are to perform the recited operations.

Notwithstanding the foregoing, claims 1 and 17 have been amended to recite a “processing node,” which comprises hardware capable of implementing the recited operations.

#### Claim Rejections – 35 U.S.C. § 102

Claims 1-5 and 17 were is rejected under 35 U.S.C. 102(e) as being anticipated by Matheny et al. (US 2002/0161883). Applicants respectfully traverse.

The test for anticipation under 35 U.S.C. § 102 requires is outlined in MPEP 2131, as follows:

““A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).”

\* \* \*

““ The identical invention must be shown in as complete detail as is contained in the ... claim.’ Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).”

In other words, an anticipation reference faces a two-prong requirement. First, the reference must disclose each element of the claim under consideration. W.L. Gore & Assocs. v.

Garlock, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983) (cert. denied, 469 U.S. 851 (1984)).

Second, the reference may not disclose the claim elements in isolation -- they must be “arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). As part of the anticipation analysis, the claim language must be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Bond*, 910 F.2d 83, 15 U.S.P.Q. 2d (Fed. Cir. 1990).

It is the Examiner’s burden to establish *prima facie* anticipation. *In re Piasecki*, 223 U.S.P.Q. 785, 778 (Fed. Cir. 1984) (“As adapted to ex parte procedure, Graham is interpreted as continuing to place the ‘burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103’ (quoting *In re Warner*, 379 F.2d 1011, 154 U.S.P.Q. 173, 178 (CCPA 1967) (cert. denied 389 U.S. 1057 (1968))). As stated by the Board, “[i]t is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.” *In re Skinner*, 2, U.S.P.Q. 1788, 1788-89 (B.P.A.I. 1986). See also *In re Oetiker*, 997 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1982) (“If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent.”).

#### Claim 1

With respect to independent claim 1, Matheny does not disclose at least the claim element reciting that “collectively, said agent discovery assignments being a subset of said agent discovery capabilities.” Paragraph [0019] of Matheny is cited as disclosing this claim element. Although this paragraph refers to checking a matrix derived from registration files to determine agent capabilities, it does not say anything about the agent assignments being a subset of the

agent discovery capabilities. In fact, Matheny states just the opposite, namely, that the agents perform overlapping discovery (presumably using their full discovery capabilities). See paragraph [0025], stating that “[t]he same device may be discovered multiple times, by different discovery agents.” The overlapping search results are then pruned to remove redundant search information. See paragraph [0025], stating that “[i]dentical information for the same device, as identified by the file name, may be eliminated.” See also Matheny’s claim 1, which reads:

“1. A method comprising:

receiving discovery data collected from a network device by two or more discovery agents;

aggregating said discover data;

coalescing the discovery data in a discovery document, said discovery data including two or more duplicate data entries; and

removing all but one of the duplicate data entries from the discovery document.”

Because Matheny lacks disclosure of all elements of applicants’ claim 1, the anticipation rejection may be properly withdrawn.

### Claim 2

Dependent claim 2 should be allowable based on its dependence from claim 1. In addition, Matheny does not disclose that “collectively, said agent discovery capabilities are overlapping and said agent discovery assignments are substantially non-overlapping.” See discussion of claim 1 above.

### Claim 3

Dependent claim 3 should be allowable based on its dependence from claim 1.

#### Claim 4

Dependent claim 4 should be allowable based on its dependence from claim 1. In addition, Matheny does not disclose that “said agent discovery assignments reflect one or more of data collection service registrations with said plural discovery agents, agent cost to obtain network information, load balancing among said plural discovery agents, and assignment churn.”

Support for the agent discovery assignments reflecting data collection server registrations is found in the specification on page 24, line 18 – page 25, line 7, which discusses how a network manager can register as a client of discovery services provided by a discovery agent. Support for agent discovery assignments reflecting agent cost, load balancing and assignment churn is found in the specification on page 19, lines 3-6.

Paragraph [0017] of Matheny is cited against claim 4. This paragraph states that agents report their own capabilities to the discovery manager by placing an XML file describing the agent attributes in a discovery database. There is no mention of any of the agent assignment considerations recited in claim 4. Ditto for paragraph [0019], which further elaborates on Matheny’s agent assignment procedure. Paragraph [0019] states that the network manager selects agents based on network address and subnet ranges.

#### Claim 5

Dependent claim 5 should be allowable based on its dependence from claim 1.

#### Claim 17

With respect to independent claim 17, Matheny does not disclose at least the claim element that reads “discovery capability logic associated with said processing node adapted to determine and provide agent discovery capability information to a requestor, said agent discovery

capability information being a subset of all discovery information obtainable by said agent.”

Support for this claim element is found in the specification in the section entitled “Determining Agent Capabilities” beginning on page 15. Fig. 8 shows periodic agent capability polls 90 and page 16, lines 6-10 describes how the capability polls may be less comprehensive than a full discovery poll in order to maximize network management performance.

Paragraph [0019] of Matheny is cited as disclosing this claim element. Although paragraph [0019] discusses agent capabilities, it does not discuss the procedure for determining the agent capabilities. That is done in the agent registration operation of paragraph [0017], which states that agents report their own capabilities to the discovery manager by placing an XML file describing the agent attributes in a discovery database. There is no mention of an agent determining and providing agent discovery capability information that is a subset of all discovery information obtainable by the agent.

In view of the foregoing, Applicants respectfully request that all rejections be withdrawn and that Notices of Allowability and Allowance be issued.

Respectfully submitted,

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